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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,329	12/31/2003	Edgar Matias	PI282US00	8128
54640 7590 04/08/2008 PERRY + CURRIER INC. 1300 YONGE STREET SUITE 500 TORONTO, ON M4T-1X3 CANADA				
EXAMINER				
PICKETT, JOHN G				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
04/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,329

Applicant(s)

MATIAS ET AL.

Examiner

J. Gregory Pickett

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 21 January 2008 has been entered. Claims 6, 7, and 9-11 are pending in the application. Claims 1-5 and 8 have been canceled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 6, 7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shawler (US 4,899,888; provided by applicant) in view of Geary et al (US 6,899,946; hereinafter Geary) and Aileo (US 3,943,572).

Claims 6 and 9: Shawler discloses a carrying case **10** with adaptable internal dimensions comprising a plurality of internal sidewalls **14, 16, 18 & 20**, and a plurality of stackable, shock-absorbent spacers **101-106** removably coupled to one another (Col. 4, lines 38-44).

Shawler discloses the claimed invention except for the express disclose of the adhesive on both sides of each spacer and the box wall, in addition to the adhesive being hook-and-loop fasteners.

Shawler uses adhesive instead of hook-and-loop fasteners. Geary shows that hook-and-loop fasteners were an equivalent structure known in the art (see Col. 4, lines 54-59). Therefore, because these two connecting means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute hook-and-loop fasteners for the adhesive of Shawler. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

As to the adhesive on both sides and the box wall, Aileo teaches the provision of the hook-and-loop fasteners **86/88** on both sides of the foam spacers **82/84** and the mounting location **74** in order to connect two or more shock absorbing pads (see for example Col. 4, lines 24-26 and Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the hook-and-loop fasteners of Shawler-Geary on both sides of the spacers and the box sidewalls (i.e. the mounting location) as taught by Aileo in order to connect two or more spacers.

Claim 7: Shawler discloses impact-absorbing bodies **101-106**.

Claim 10: Shawler discloses lightweight foam (Col. 3, lines 57-61).

Claim 11: Shawler discloses the parallelepiped shape (see Col. 4, lines 33-35 and Figure 2B).

Response to Arguments

4. Applicant's arguments filed 21 January 2008 have been fully considered but they are not persuasive. The arguments are entirely dependent upon the commercial success of the invention as presented in the declaration under 37 CFR 1.132 filed 21 January 2008.

The declaration under 37 CFR 1.132 filed 21 January 2008 is insufficient to overcome the rejection of claims 6, 7, and 9-11 based upon Shawler, Geary et al and Aileo as set forth in the last Office action because:

To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). Applicant bears the burden of proof.

Initially it is noted that gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985).

Commercial success must be derived from the claimed invention (MPEP 716.03(b)). The only evidence of record that the commercial success is derived from the claimed invention is the opinion evidence of the inventors (Declaration section 13),

who have a vested interest in the patenting of the claims. Aside from the opinion evidence of the inventors, there is no further evidence that the purchase by Alienware or Dell was due to the claimed stackable shock-absorbent spacers instead of other features of the product or aggressive sales. In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). Applicant has not effectively established a nexus between the commercial success and the claimed invention.

Moreover, evidence of commercial success must be commensurate in scope with the claims (MPEP 716.03(a)). Exhibit "A" is not commensurate in scope with the claimed invention and is therefore ineffective in overcoming the rejection presented. Exhibit "A" is directed to a device made from an aluminum material (line 1) and is a sealed case (line 6). Neither of these features is claimed; and both are significant in their effects in protecting the retained computer in both the environment and the drop incident. Further, Exhibit "A" only describes a "padded case" (line 7), and does not attribute the performance of the device or desirability to purchase the device to the

claimed stackable shock-absorbent spacers. Exhibit "A" is not commensurate in scope with the claimed invention and cannot be effective in overcoming the rejection at hand.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728